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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,951	08/28/2003	Jia-He Li	70003.0002USD1	6259
30678	7590	10/21/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP SUITE 800 1990 M STREET NW WASHINGTON, DC 20036-3425			REYES, HECTOR M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,951

Applicant(s)

LI ET AL.

Examiner

Hector M Reyes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 47-60 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Restriction Request

In view of Applicant's Preliminary Amendment wherein claims 1-46 and 61-118 have been canceled, **previous restriction request is vacated** and the following **NEW** restriction presented is required and directed to current active claims 47-60

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 47-48, 50-51, 53-57 in part, drawn to **nonheterocyclic derivatives** of formula IV including its salts, its pharmaceutical compositions pharmaceutically acceptable nonheterocyclic **prodrug** or its corresponding salts and pharmaceutically active nonheterocyclic **metabolites** derivatives of formula IV or its corresponding salts, and pharmaceutical compositions comprising the same classified in multiple classes and subclasses. A single disclosed specie is requested for search purposes.
- II. Claims 47-57 in part, drawn to **heterocyclic derivatives** of formula IV including its salts, and pharmaceutical compositions, acceptable heterocyclic **prodrug** or its corresponding salts and pharmaceutically active heterocyclic **metabolites** derivatives of formula IV or its corresponding salts, and pharmaceutical compositions comprising the same classified in multiple classes and subclasses. A single disclosed specie is requested for search purposes.

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- III. Claims 58-60 in part, drawn to method of using nonheterocyclic derivatives of formula IV including its salts, and its pharmaceutical compositions, pharmaceutically acceptable nonheterocyclic prodrug or pharmaceutically active nonheterocyclic metabolites derivatives of formula IV or its corresponding salts, classified in multiple classes and subclasses. This group may be subjected to further restriction. A single disclosed specie is requested for search purposes.
- IV. Claims 58-60 in part, drawn to method of using heterocyclic derivatives of formula IV including its salts, and pharmaceutical compositions, pharmaceutically acceptable heterocyclic prodrug or pharmaceutically active heterocyclic metabolites derivatives of formula IV or its corresponding salts, classified in multiple classes and subclasses. This group may be subjected to further restriction. A single disclosed specie is requested for search purposes.

The inventions are distinct, each from the other because of the following reasons:

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case:

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- Inventions I and II are unrelated because they are different inventions since each one of the said groups are drawn to compounds having a particular core per groups-and its corresponding pharmaceutical compositions, and the compounds embraced in each group have its own reactivity, structure and variable groups. Indeed a reference anticipating or suggesting a given group cannot be used to reject any of the others under the meaning of 35 USC 102 or 35 USC 103.
- Inventions III and IV are unrelated because each one of the said groups are drawn to methods of using different sets of compounds embraced by different groups already shown to be a separate and distinct inventions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for any group is not required any of the others, restriction for examination purposes as indicated is proper.

In the particular case that Applicant elect a group drawn to particular chemical compounds, and the compounds are found allowable, the Examiner is kindly

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willing to rejoin claims drawn to particular method of using the said compounds but limited to the allowable scope of the compounds and provided that the claims to be rejoined are not reach through claims and they are free from any 112 issues.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete **must** include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (571) 272-0691. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rita Desai can be reached on (571) 272 0684. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hector M. Reyes, PhD JD
USPTO Reg. # P-54846
AU 1625
October 18, 2004

**RITA DESAI
PRIMARY EXAMINER**

R. Desai
10/18/04